

### **REMARKS**

The Final Office Action mailed April 26, 2005 has been received and reviewed. All claims stand rejected. Applicants respectfully request reconsideration of the present Application. Claims 2, 4, and 5 have been amended herein. Specifically, Claims 2 and 4 have been amended to better clarify what the Applicants consider to be their invention, and Claim 5 has been amended to correct a typographical error. Claim 6 has been added as a new claim and is supported in the application by paragraphs [0025]-[0032]. Care has been exercised to introduce no new matter. Claims 2-6 are pending and are in condition for allowance.

### **Rejections based on 35 U.S.C. § 103**

Title 35 U.S.C. § 103(a) declares that a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, suggestion, or motivation found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. *See Application of Bergel*, 292 F.2d 955, 956–57 (Fed. Cir. 1961).

Recently, the Supreme Court emphasized that the standard for obviousness is not rigid and should not be applied as such. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). Instead, if the common sense of those skilled in the art could demonstrate why some combinations would have been obvious where others would not, then a claim can be found obvious even without an explicit teaching, suggestion, or motivation. As the Court stated in *KSR*, “it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *Id.* at 1740–41.

Claims 2-5 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,034,524 to Shiokawa et al. (“Shiokawa”) in view of U.S. Patent No. 5,945,445 to Barringer et al. (“Barringer”). Because one skilled in the art would not be motivated to combine these references, Applicants respectfully traverse this rejection, as hereinafter set forth.

The Examiner argues that it would have been obvious for one of ordinary skill in the art to combine the macrocyclic lactones disclosed in Shiokawa with the agonist or antagonist of the nicotineric acetylcholine receptors disclosed in Barringer. Prior art references, however, cannot be used to render an invention obvious if they teach away from the claimed invention, which is exactly what the Barringer reference does. MPEP § 2145; *In re Grasselli*, 713 F.2d 731, 743, 218, USPQ 769, 779 (Fed. Cir. 1983). Throughout its specification, Barringer teaches using an insecticide with avermectin, a macrocyclic lactone, as an active ingredient against pine wilt nematodes and also against Japanese pine sawyers. Nematodes can be classified as an endoparasite, or a parasite that functions inside the body of the host. The Japanese pine sawyer, on the other hand, is a type of longicorn beetle that is classified as an ectoparasite, or one that

lives outside of its host. Thus, the insecticide disclosed in Barringer is intended to treat both endoparasites and ectoparasites.

In the present application, macrocyclic lactones are used as an active ingredient to treat endoparasites. The agonists or antagonists of the nicotinergeric acetylcholine receptors are used to treat ectoparasites. Because Barringer teaches using avermectin against both ectoparasites and endoparasites, one of ordinary skill in the art would not be motivated to combine the use of avermectin with the use of agonists or antagonists of the nicotinergeric acetylcholine receptor based on the teachings of Shiokawa. Barringer, in fact, does more than just disclose using avermectin to treat ectoparasites. Several of the examples are specifically aimed at treating the Japanese Pine Sawyer, an ectoparasite. If, based on Barringer, one skilled in the art knew a composition of avermectin treated both ecto- and endoparasites, there would be no motivation to add another active ingredient to the composition to separately treat ectoparasites, and thus they would not look to Shiokawa for further guidance. Accordingly, Barringer teaches away from combining these prior art references.

Because Barringer teaches away from combining the teachings of Barringer with Shiokawa, Applicants submit that these references do not anticipate claims 2-5. As such, Applicants respectfully request the withdrawal of the 35 U.S.C. § 103(a) rejection against these claims. Additionally, new claim 6 is patentable over these references, as it depends from claim 3.

### **CONCLUSION**

For at least the reasons stated above, and upon entry of the amendments proposed herein, claims 2-6 are believed to be in condition for allowance. As such, Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any

issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action.

It is believed that no additional fee is due in conjunction with the present communication. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,

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